



Docket No.: 0933-0210P  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Mart SAARMA et al.

Application No.: 10/648,361

Confirmation No.: 3435

Filed: August 27, 2003

Art Unit: 1633

For: NOVEL NEUROTROPHIC FACTOR  
PROTEIN AND USES THEREOF

Examiner: M. Marvich

**INFORMATION DISCLOSURE STATEMENT**  
**(SUBMISSION AFTER FILING OF AN APPLICATION BUT BEFORE FINAL**  
**REJECTION OR NOTICE OF ALLOWANCE OR CONCURRENTLY WITH A RULE**  
**1.114 RCE APPLICATION)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-SB08(s), attached hereto.

II. COPIES

- ☒ a. Copies of cited U.S. patents and patent application publications are not included.  
Copies of foreign patent documents and non-patent literature are included.

☐ b. Some or all of the documents listed on the PTO-SB08 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

☐ c. REFERENCES PREVIOUSLY CITED OR SUBMITTED - Pursuant to 37 C.F.R. §1.98(d), consideration of information listed on the PTO-SB08 form(s) is requested since any patents, publications, or other information which are listed on the PTO-SB08 form(s) but for which copies are not enclosed herewith, were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

U.S. Appl. No(s) and U.S. Filing Date

60/406,927 filed August 30, 2002

III. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

☒ a. DOCUMENTS IN THE ENGLISH LANGUAGE - The patents, publications, or other information listed on the attached PTO SB08 are in the English language and therefore, do not require a statement of relevancy.

☐ b. DOCUMENTS NOT IN THE ENGLISH LANGUAGE - A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows:

☐ c. ENGLISH LANGUAGE SEARCH REPORT - An English language version of the search report or action that indicates the degree of relevance found by the foreign office is attached, thereby satisfying the requirement for a concise explanation. See MPEP 609(III)(A)(3).

☐ d. OTHER - The following additional information is provided for the Examiner's consideration.

IV. FEES (check one box)

☐ a. This Information Disclosure Statement is being filed concurrently with the filing of a new patent application; therefore, no fee is required.

☐ b. This Information Disclosure Statement is being filed concurrent with the filing of a continuation-in-part, continuation, or divisional patent application; therefore, no fee is required.

☐ c. This Information Disclosure Statement is being filed within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required.  
*(This section is not to be used with RCE's.)*

☐ d. This Information Disclosure Statement is being filed within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.

☒ e. This Information Disclosure Statement is being filed concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.

☐ f. This Information Disclosure Statement is being filed before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account for the fee as required by 37 C.F.R. § 1.17(p).

☐ g. This Information Disclosure Statement is being filed before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

☐ No statement; therefore, a fee as required by 37 C.F.R. § 1.17(p) is attached.

or

☐ See the statement below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)

(check only one box)

The undersigned hereby states that:

☐ a. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS; or

☐ b. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or

☐ c. No item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

☐ d. Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VI. PAYMENT OF FEES (check one box)

☐ The required fee is listed on the attached Fee Transmittal.

☒ No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated:

Respectfully submitted,

By

  
Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

Attachment(s):



PTO-SB08

Documents



PTO/SB/08A/B (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/648,361-Conf. #3435
				Filing Date	August 27, 2003
				First Named Inventor	Mart SAARMA
				Art Unit	1633
				Examiner Name	M. Marvich
Sheet	1	of	3	Attorney Docket Number	0933-0210P

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	*				

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
	BA	EP-1 033 401-A2	09-06-2000			
	BB	WO-01/19851-A2	03-22-2001			
	BC	WO-01/55317-A2	08-02-2001			
	BD	WO-01/55320-A2	08-02-2001			
	BE	WO-01/70174-A2	09-27-2001			
	BG	WO-02/070539-A2	09-12-2002			
	BH	WO-02/074956-A2	09-26-2002			
	BI	WO-02/098902-A2	12-12-2002			

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. \* CITE NO.: Those application(s) which are marked with an single asterisk (\*) next to the Cite No. are not supplied (under 37 CFR 1.98(a)(2)(iii)) because that application was filed after June 30, 2003 or is available in the IFW. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/648,361-Conf. #3435
				Filing Date	August 27, 2003
				First Named Inventor	Mart SAARMA
				Art Unit	1633
				Examiner Name	M. Marvich
Sheet	2	of	3	Attorney Docket Number	0933-0210P

NON PATENT LITERATURE DOCUMENTS				
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>	
•	CA	Airaksinen et al., Nature Reviews Neuroscience, Vol. 3, 383-394, May 2002.		
	CB	Genbank Accession NO. AX573504: WO 02/079246 A 8 10-Oct-2002. ✓		
	CC	Genbank Accession No. BC037872: R. Strausberg, NIH-MGC Project, National Institutes of Health, Mammalian Gene Collection (MGC), Submitted (16-SEP-2002)		
	CD	Genbank Accession No. AI807908: NCI-CGAP, National Cancer Institute, Cancer Genome Anatomy Project, Tumor Gene Index, Unpublished (1997)		
	CE	Genbank Accession No. BI464979: NIH-MGC, National Institutes of Health, Mammalian Gene Collection (MGC), Unpublished (1999)		
	CF	Genbank Accession No. BG742840: NIH-MGC, National Institutes of Health, Mammalian Gene Collection (MGC) Unpublished (1999)		
	CG	Genbank Accession No. F31353: G. Lanfranchi et al., Genome Res. 6 (1), 35-42 (1996)		
	CH	Genbank Accession No. BG742772: NIH-MGC, National Institutes of Health, Mammalian Gene Collection (MGC), Unpublished (1999)		
	CI	Genbank Accession No. AA018863: L. Hillier et al., Genome Res. 6 (9), 807-828 (1996)		
	CJ	Genbank Accession No. AV657190: X Xu et al., Proc. Natl. Acad. Sci. USA 98 (26), 15089-15094 (2001)		
	CK	Genbank Accession No. BD030478: J. B. D. M. Edwards et al., JP 2001-269182-A 6724 02-OCT-2001		
	CL	Genbank Accession No. AK034009: P. Caminci et al., Meth. Enzymol. 303, 19-44 (1999) P. Caminci et al., Genome Res. 10 (10), 1617-1630 (2000) K. Shibata et al., Genome Res. 10 (11), 1757-1771 (2000) J. Kawai et al., Nature 409 (6821), 685-690 (2001) The Fantom Consortium and the RIKEN Genome Exploration Research Group Phase I & II Team, Nature 420, 563-573 (2002) J. Adachi et al., The Institute for Physical and Chemical Research (RIKEN), Submitted (16-JUL-2001)		
	CM	Genbank Accession No. BB625884: T. Arakawa et al., Laboratory for Genome Exploration Research Group, RIKEN Genomic Sciences Center, Unpublished (2001)		
	CN	Genbank Accession No. BI964826: D. Melton et al., Endocrine Pancreas Consortium, Harvard University, Howard Hughes Medical Center, Unpublished (2000)		
	CO	Genbank Accession No. AX573503: L. Bougueleret et al., WO 02/079246-A 7 10-OCT-2002		
	CP	Genbank Accession No. AC069544: D. R. Smith, Genome Therapeutics Corp. Submitted (02-JUN-2000) D. R. Smith, Genome Therapeutics Corp. Submitted (21-DEC-2001) D. R. Smith, Genome Therapeutics Corp. Submitted (25-APR-2002)		
	CQ	Genbank Accession No. AQ412924: S. Zhao et al., Department of Eukaryotic Genomics, The Institute for Genomic Research, Unpublished (1997)		
	CR	Genbank Accession No. AX573508: L. Bougueleret, WO 02/079246-A 12 10-OCT-2002		
	CS	Genbank Accession No. AZ537498: G. Henkel; Aurora Biosciences Corp, Unpublished (2000)		
	CT	Genbank Accession No. AI214900: NCI-CGAP, National Cancer Institute, Cancer Genome Anatomy Project (CGAP), Tumor Gene Index, Unpublished (1997)		

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete If Known</b>	
				Application Number	10/648,361-Conf. #3435
				Filing Date	August 27, 2003
				First Named Inventor	Mart SAARMA
				Art Unit	1633
				Examiner Name	M. Marvich
Sheet	3	of	3	Attorney Docket Number	0933-0210P

	CU	Genbank Accession No. BG213461: J. J. Harrington, Nat. Biotechnol. 19 (5), 440-445 (2001)	
	CV	Genbank Accession No. BI963176: D. Melton, Endocrine Pancreas Consortium, Harvard University, Howard Hughes Medical Institute, Unpublished (2000)	
	CW	Genbank Accession No. AA725810: NCI-CGAP, National Cancer Institute, Cancer Genome Anatomy Project (CGAP), Tumor Gene Index, Unpublished (1997)	
	CX	Genbank Accession No. AX573502: L. Bougueleret et al., WO 02/079246-A 6 10-OCT-2002	
	CY	Genbank Accession No. AX573525: L. Bougueleret et al., WO 02/079246-A 29 10-OCT-2002	
	CZ	Genbank Accession No. AX573507: L. Bougueleret et al., WO 02/079246-A 11 10-OCT-2002	
	CA1	Genbank Accession No. AA018896: L. Hillier et al., The WashU-Merck EST Project, Washington University School of Medicine, Unpublished (1995)	
	CB1	Genbank Accession No. BF150043: NCI-CGAP, National Cancer Institute, Cancer Genome Anatomy Project (CGAP), Tumor Gene Index, Unpublished (1997)	
	CC1	Genbank Accession No. AA885943: NCI-CGAP, National Cancer Institute, Cancer Genome Anatomy Project (CGAP), Tumor Gene Index, Unpublished (1997)	
	CD1	Genbank Accession No. AX573506: L. Bougueleret et al., WO 02/079246-A 10 10-OCT-2002	
	CE1	Genbank Accession No. AX573505: L. Bougueleret et al., WO 02/079246-A 9 10-OCT-2002	
	CF1	Genbank Accession No. CB785684: Amgen EST Program, Amgen, Inc., Unpublished (2003)	
	CG1	Genbank Accession No. AQ458921: G. G. Mahairas et al., Proc. Natl. Acad. Sci. USA 96 (17) 9739-9744 (1999)	
	CH1	Genbank Accession No. AAH07282: R. Strausberg, National Institutes of Health, Mammalian Gene Collection (MGC), Submitted (01-MAY-2001)	
	CI1	Genbank Accession No. AAB08753: V. Shridhar et al., Oncogene 12 (9), 1931-1939 (1996)	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--